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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,978	02/08/2002	Vincent J. Gatto	EP-7532	3784

7590 07/13/2005

Mr. Dennis H. Rainear
Patent & Trademark Division
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330 South Fourth Street
Richmond, VA 23219

EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/067,978	Applicant(s) GATTO, VINCENT J.	
	Examiner Jerry D. Johnson	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-17,19-24,26-28,37-40,42,47,48 and 50-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,6-17,19-24,26-28,37, 38, 40,48 and 50-62 is/are allowed.
- 6) ☒ Claim(s) 39,42,47 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

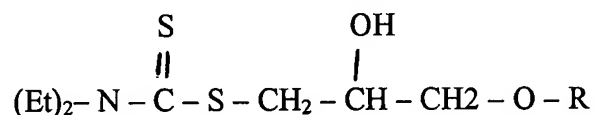
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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 6, 2005 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 39, 42 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belov et al.

Belov et al. disclose hydroxy-substituted dithiocarbamate lubricant additives of the formula



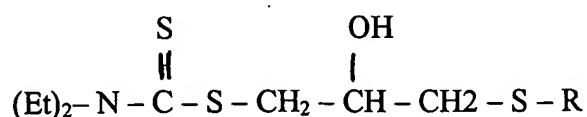
wherein R is a C₄ or C₁₀ hydrocarbon. While Belov et al. differ from the instant claims in not disclosing the specifically claimed compounds, the claimed compounds are homologues of the compounds taught by Belov et al. and would have been obvious to one having ordinary skill in the art at the time the invention was made based on the reasonable assumption that the homologues would have similar properties.

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto et al. in view of Latyuk et al.

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Gatto et al., U.S. Patent 6,174,842, teach lubricating oil compositions comprising a major amount of an oil of lubricating viscosity comprising at least one oil-soluble molybdenum compound substantially free of reactive sulfur which provides about 50 to 1000 ppm of molybdenum to the lubricating composition, about 1000 to 20,000 ppm of at least one oil-soluble diarylamine and about 2,000 to 40,000 ppm of at least one alkaline-earth metal phenate detergent (column 3, lines 6-14). Oil-soluble molybdenum compounds are disclosed in column 4, line 48 to column 5, line 56. The composition of the lubricant oil can vary significantly based on the customer and specific application. The oil may contain, in addition to the three-component system according to the invention, a detergent/inhibitor additive package and a viscosity index improver (column 8, lines 53-57). The detergent/inhibitor additive package may include dispersants, detergent, zinc dihydrocarbyl dithiophosphates (ZDDP), additional antioxidants, pour point depressants, corrosion inhibitors, rust inhibitors, foam inhibitors and supplemental friction modifiers (column 8, lines 63-67). Generally, the ZDDP is present in the finished oil between about 0.25 and 1.5 wt.%. It is desirable from environmental concerns to have lower levels of ZDDP. Phosphorus-free oils contain no ZDDP (column 9, lines 28-31). The base oil may be selected from any of the synthetic or natural oils or mixtures thereof (column 9, lines 45-47). While Gatto et al. teach the addition of other functional additives, Gatto et al. differ from the instant claims in not teaching the claimed hydroxy-substituted dithiocarbamates.

Latyuk et al. disclose alkylthiopropanol-2-derivatives multifunctional lubricant additives having good antiwear, antiscuff and anticorrosion properties of the formula



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wherein R is a C₂, C₃, C₄ or C₅ hydrocarbon. While Latyuk et al. differ from the instant claims in not disclosing the specifically claimed compounds, the claimed compounds are homologues of the compounds taught by Latyuk et al. and would have been obvious to one having ordinary skill in the art at the time the invention was made based on the reasonable assumption that the homologues would have similar properties.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a hydroxy-substituted dithiocarbamate as taught by Latyuk et al. to a lubricating composition as taught by Gatto et al. in order to improve the antiwear, antiscuff and anticorrosion properties of said lubricating composition.

Applicant's arguments filed April 6, 2005 have been fully considered but they are not persuasive.

Applicant argues

Claims 39, 42, 47, and 63 have been amended to specify the means by which the compounds are obtained, a feature neither disclosed nor taught in the Latyuk et al. and Belov et al. references. (Remarks, page 14).

Applicant's argument lacks merit.

The patentability of a product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

Claims 1, 3, 6-17, 19-24, 26-28, 37, 38, 40, 48 and 50-62 are allowed.

The compositions and compounds of claims 1, 3, 6-17, 19-24, 26-28, 37, 38, 40, 48 and 50-62 differ from the prior art in requiring the presence of at least one C₈ to C₂₂ alkyl substituent on the nitrogen atom of the dithiocarbamate whereas the compounds of the prior art are C₂ alkyl.

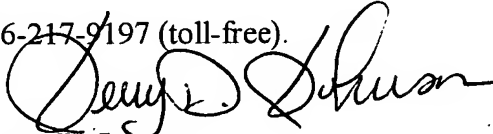
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448.

The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jerry D. Johnson
Primary Examiner
Art Unit 1764

jdj